

Remarks

Claims 1-15 were pending. Claim 1 has been amended to emphasize that the emulsion is an oil-in-water emulsion, but that when the product is whipped with sugar, it behaves as a water-in-oil emulsion. Support for this amendment is found at page 10, lines 8-11. Claim 15 has been cancelled.

Election/Restriction

With respect to the Restriction requirement, the Examiner states in the Office Action (page 2, lines 4-6 of the first paragraph) that “*Claims 1-7 and 16-20 have been cancelled and elected claim 8-15 and 21-24 are pending*”. Applicants believe the Examiner intended to state that claims 16-22 (Group II) and 23-27 (Group III) have been cancelled and that claims 1-15 are pending. Clarification is respectfully requested.

Claims Rejection - 35 USC 112

The Examiner has rejected the claims as being indefinite. With respect to the percentages of components in the claims, these are provided as weight percent as is the convention in the art. Further, support can be found in the provisional patent application, Serial Number 60/456,261 (which disclosure was incorporated by reference) in Example 1 at page 8, where the components are listed in percentages in one column and listed in grams in the next column. Thus, the percentages are weight percentages.

With respect to the term, “whippable food product”, the recited percentages are with respect to the unwhipped product. The preamble of the claim recites a “whippable food product” and the term “whippable” indicates the product is unwhipped and therefore the claim recites the percentages in the unwhipped product.

Claims Rejection - 35 USC 103

The Examiner has rejected claims 1-15 as being obvious over Lynch (U.S. Patent No. 6,203,841 - which has the same assignee as the present application) - column 20, lines 25-45

(hereinafter the "Cited '841 Product"). The Applicants respectfully request reconsideration for the following reasons.

Applicants respectfully point out that the present claims recite a formulation that comprises the recited amount of fat and both polysorbate 60 and polysorbate 80. Applicants point out that the advantage of using both polysorbate 60 and polysorbate 80 is described in page 14, lines 9-14 of the present Specification. For example, if both polysorbate 60 and polysorbate 80 are not used, then the rosette time is decreased from 1 hour to 15 minutes. Thus, both polysorbate 60 and polysorbate 80 are required for the present invention.

Further, the claims as amended require that the present product be capable of undergoing inversion (i.e., behaves as an oil-in-water emulsion, but in the presence of added sugar, behaves as a water-in-oil emulsion). Applicants believe that it is the combination of the fat percentages between 30 and 40% and the presence of both polysorbate 60 and polysorbate 80 at the recited percentages that contributes to the product having this property. In support of this, Applicants respectfully submit a declaration under Rule 1.132 by one of the inventors, Andrew Fendinger. The declaration details experiments conducted to compare the properties of the product of the present invention with the Cited '841 Product.

As described in the Rule 132 Declaration, the two products were compared by whipping them with and without sugar. As can be seen on page 2 of the Rule 132 declaration, the product of the present invention whipped to a desired texture in significantly less time than the Cited '841 Product. Both the whipped products were then placed in water to determine whether the products behaved as oil-in-water emulsions or water-in-oil emulsions. If the whipped product is an oil-in-water emulsion (meaning the continuous phase is water), upon placing in water, dis-association occurs and it will begin to mix into the water. On the other hand, if the whipped product is a water-in-oil emulsion (meaning the continuous phase is oil) then upon placing in water, there will not be any appreciable dis-association and therefore it will not mix into water. As can be seen in Figure 1 of the Rule 132 declaration, in the absence of added sugar, both whipped products undergo disassociation and therefore mix into the water. This indicates that although the whipped product of the present invention whips in significantly less time than the Cited Product of the '841 patent, in the absence of added sugar, both form oil-in-water emulsions as evidenced by mixing into water.

However, when the products were whipped in the presence of added sugar, differences could be seen in their behavior in water. As described on page 3 of the Rule 132 Declaration, the present product with sugar whipped in significantly less time than the Cited '841 Product. Further, both of these products were placed in water and appearance recorded at 6 minutes and 1 hour. As can be seen in Figures 2A and 2B, while the Cited '841 Product can be seen mixing into water as early as 6 minutes, the present invention product is not seen to display similar mixing even at 1 hour indicating that in the presence of added sugar, the present product behaved as a water in oil emulsion, while the Cited '841 Product behaved as an oil-in-water emulsion. Differences in their behavior in water were observed whether the Cited Product was processed as described in the '841 patent or processed similar to the present formulation (Item 5.4 of the Declaration). Therefore, to summarize, the present product whips in significantly less time and is capable of undergoing inversion (behaving as water-in-oil emulsion) in the presence of added sugar, whereas the Cited Product of the '841 patent is not capable of such inversion. It is respectfully submitted that in the present invention, both polysorbate 60 and polysorbate 80 are needed for this property to be displayed. The Cited Product of the '841 patent does not have both of these emulsifiers. It is believed that this property of inversion may add to the desired organoleptic properties of the present invention and is present due to the particular combination of the recited ingredients.

In the Office Action, the Examiner contends that it would have been a matter of routine determination and optimization to specify polysorbate 80 as the emulsifier and to specify the particular amount. The Applicants respectfully note that MPEP 2144.05 B requires that "[a] particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977). . . See also *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). Nothing in the '841 patent teaches that combining emulsifiers in different concentration amounts and ranges will lead to inversion when the product is whipped with sugar. Thus, the Examiner has not established that combining emulsifiers is known to be a result-effective variable for producing invertible compositions. As such, it was not a matter of routine experimentation to find a combination of emulsifiers at particular combinations that

would cause the composition to be invertible under particular conditions, specifically, with the introduction of sugar.

Finally, nothing in Lynch '841 teaches that inversion is desirable or that adjusting these parameters leads to inversion. It is also respectfully pointed out that the Cited Product of the '841 patent is stated to be a whipped topping base (see column 20, lines 22-23; emphasis added). Therefore, one skilled in the art would not consider using it without dilution. Therefore, faced with Lynch '841, one of ordinary skill in the art would not have a reasonable expectation that requiring both polysorbate 60 and polysorbate 80 emulsifiers at the recited concentration range would provide a composition that is capable of inversion when mixed with sugar, and that the inversion may result in the good organoleptic properties of the composition.

With the above arguments and amendments, the Applicants believe that the prima facie case of obviousness under 35 USC§103 has been overcome. It is respectfully requested that the Examiner withdraw the rejection under 35 USC§103 over the '841 patent to Lynch.

Conclusion

Based on the above amendments and arguments, Applicants believe that claims 1-14 are now in a condition for allowance and thus respectfully request the Examiner to allow these claims.

This response is being filed with a three-month request for extension and the late fee. If any additional fee is due, the Director is hereby authorized to charge it to Deposit Account 08-2442 of the undersigned.

Respectfully submitted,
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By


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Enc. Rule 132 Declaration of Andrew Fendinger